UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/484,865	01/18/2000	Fred Albert Dykins	1015-011	1215

22898 7590 03/08/2005

THE LAW OFFICES OF MIKIO ISHIMARU
1110 SUNNYVALE-SARATOGA ROAD
SUITE A1
SUNNYVALE, CA 94087

EXAMINER	
TANG, KENNETH	

ART UNIT	PAPER NUMBER
2127	

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/484,865	DYKINS ET AL.	
	Examiner	Art Unit	
	Kenneth Tang	2127	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 November 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,7-16 and 19-50* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,7-16 and 19-50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This final action is in response to the Amendment on 11/5/04. Applicant's arguments have been fully considered but were not found to be persuasive.

2. Claims 1-4, 7-16, and 19-50 are presented for examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-4, 7-16, and 19-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In claim 1, "processing microdevices" (line 26) is indefinite because it is not made explicitly clear in the claim language if the computer, legacy, and/or the non-legacy system processes the microdevices. It is unclear in the microdevices are a part of the legacy system, the non-legacy system, or neither. There is no link or relationship that connects microdevices to these systems. Claims 13, 26, and 38 are rejected for the same reasons.

b. In claim 1, there is no link or relationship established between "non-legacy information" (line 14) and "system setup and shutdown parameters" (line 15) and "system process-specific parameters" (line 16), and therefore, it is not made explicitly clear in the claim language whether or not "non-legacy information" constitutes "system

setup and shutdown parameters" and "system process-specific parameters". Claim 13 is rejected for the same reasons.

c. In claim 1, "providing the number of processed microdevices to be output from the legacy processing system and the non-legacy processing system" (line 21) and "providing processing system process-specific parameters to the legacy processing system and the non-legacy processing system" (line 23) is indefinite because it is not made explicitly clear in the claim language whether the microdevices or computer system provides this. Claim 13 is rejected for the same reasons.

d. Claims 13, 26, 30, 34, 38, 42, and 46 has the same deficiency as claim 1 above. Corrections to claim 1 are also required to overcome the rejection for these claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 26-29 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tyner et al. (hereinafter Tyner) (US 6,272,618 B1) in view of Bodnar et al. (hereinafter Bodnar) (US 6,658,268 B1).

5. As to claim 26, Tyner teaches a method for processing microdevices comprising:

providing a computer system having processing information related to the microdevices as a task *(col. 6, lines 32-34, col. 3, lines 5-14 and 45-55, see Fig. 1, item 16)*;

providing a legacy processing system *(col. 6, lines 32-34)*;

providing a non-legacy processing system *(col. 6, lines 32-34)*;

providing the task from the computer system to the legacy processing system with constant interaction therebetween *(col. 6, lines 32-34, col. 3, lines 34-40)*;

performing a task by the non-legacy processing system independent of the computer system *(col. 6, lines 32-34)*.

6. Tyner fails to explicitly teach:

providing the task from the computer system to a non-legacy processing system for performing the task by the non-legacy processing system independent of the computer system, developing return non-legacy information resulting from the non-legacy processing system using the task, and returning the return non-legacy information to the computer system.

7. However, Bodnar teaches a non-legacy phone docketing (sending and receiving) both software tasks and non-legacy information between a personal computer and a non-legacy phone via a flash-based memory medium, so that the non-legacy system can then run on its own autonomously/independently from the computer system *(col. 17, lines 33-63)*. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature of providing the task from the computer system to the non-legacy processing system for performing the task by the non-legacy processing system independent of the computer system, developing return non-legacy information resulting from the non-legacy processing system using the task, and returning the return non-legacy information to the computer system to the existing

system and method of Tyner in order to transfer instructions and information, thus making both the computer and non-legacy system "smarter" *(col. 17, lines 33-63)*.

8. As to claim 27, Tyner teaches:

providing a microdevice progrnmming system in the legacy processing system, the legacy processing system having an on-line connection with said computer system *(col. 5, line 17, Fig. 1, item 30, col. 6, lines 32-34)*; and

programming the microdevices in the microdevice progrnmming system using the task provided through the on-line connection from the computer system to the processing system *(col. 5, line 17, Fig. 1, item 30, col. 6, lines 32-34)*.

9. As to claim 28, it is rejected for the same reasons as stated in the rejection of claim 26. In addition, Bodnar teaches a user mode *(see Abstract)*.

10. As to claim 29, it is rejected for the same reasons as stated in the rejection of claim 26. In addition, Tyner and Bodnar fail to explicitly teach having an administrator mode. However, "Official Notice" is taken that both the concept and advantages of an administrator is well known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to an administrator mode to the existing system and method in order to provide control and security.

11. As to claim 37, Tyner and Bodnar fails to explicitly teach providing an administrator mode and protecting provision of the operator mode using a password input in the administrator mode. However, "Official Notice" is taken that both the concept and advantages of providing an administrator mode and protecting provision of the operator mode using a password input in the administrator mode is well known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include providing an administrator mode and protecting provision of the operator mode using a password input in the administrator mode to the existing system and method in order to provide security.

12. **Claims 38-41 and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tyner et al. (hereinafter Tyner) (US 6,272,618 B1) in view of Bodnar et al. (hereinafter Bodnar) (US 6,658,268 B1), and further in view of Coburn et al. (hereinafter Coburn) (US 2002/0120921 A1).**

13. As to claim 38, it is rejected for the same reasons as stated in the rejection of claim 26. In addition, Tyner in view of Bodnar fails to explicitly teach using a programmer/feeder system. However, Coburn teaches using a progammer/feeder system consisting of robots, computers, programmable logic controllers, mills, drills, stamps, clamps, sensors, transfer bars, assemblers, etc. because almost every industry has recognized its advantage that use of automated assembly and machining lines to form and assemble product components and assemblies reduce manufacturing time, reduces product costs, and increases product quality *(page 1, [0005])*. It

would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature of a programmer/feeder system to the existing system of Tyner and Bodnar in order to gain the advantages mentioned above.

14. As to claim 39, it is rejected for the same reasons as stated in the rejection of claim 27.

15. As to claim 40, it is rejected for the same reasons as stated in the rejection of claim 28.

16. As to claim 41, it is rejected for the same reasons as stated in the rejection of claim 26. In addition, Tyner, Bodnar, and Coburn fail to explicitly teach having an administrator mode. However, "Official Notice" is taken that both the concept and advantages of an administrator is well known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to an administrator mode to the existing system and method in order to provide control and security.

17. As to claim 49, Tyner, Bodnar, and Coburn fails to explicitly teach providing an administrator mode and protecting provision of the operator mode using a password input in the administrator mode. However, "Official Notice" is taken that both the concept and advantages of providing an administrator mode and protecting provision of the operator mode using a password input in the administrator mode is well known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include providing

an administrator mode and protecting provision of the operator mode using a password input in the administrator mode to the existing system and method in order to provide security.

18. As to claim 50, Bodnar teaches providing information for affecting changes selected from a group consisting of software, firmware, and a combination thereof by using the portable memory medium *(col. 17, lines 33-63)*.

19. **Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tyner et al. (hereinafter Tyner) (US 6,272,618 B1) in view of Bodnar et al. (hereinafter Bodnar) (US 6,658,268 B1), and further in view of Kenik et al. (hereinafter Kenik) (US 4,821,197).**

20. As to claim 33, Tyner in view of Bodnar fails to explicitly teach combining a plurality of tasks to define a kit and performing the processing of a kit through the off-line connection. However, Kenik teaches using kits to perform off-line subassemblies *(col. 5, lines 33-44)*. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature of combining a plurality of tasks to define a kit and performing the processing of a kit through the off-line connection because this allows for tracking, updating and maintaining inventory *(col. 5, lines 33-44)*.

21. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tyner et al. (hereinafter Tyner) (US 6,272,618 B1) in view of Bodnar et al. (hereinafter Bodnar) (US 6,658,268 B1), further in view of Coburn et al. (hereinafter Coburn) (US 2002/0120921 A1), and further in view of Kenik et al. (hereinafter Kenik) (US 4,821,197).

22. As to claim 45, Tyner, Bodnar, and Coburn fail to explicitly teach combining a plurality of tasks to define a kit and performing the processing of a kit through the off-line connection. However, Kenik teaches using kits to perform off-line subassemblies *(col. 5, lines 33-44)*. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature of combining a plurality of tasks to define a kit and performing the processing of a kit through the off-line connection because this allows for tracking, updating and maintaining inventory *(col. 5, lines 33-44)*.

Allowable Subject Matter

23. Claims 1-4, 7-16, and 19-25 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

24. Claims 30-32, 34-36, 42-44, and 46-48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

25. Applicant argues on page 4 that the term "processing microdevices" (line 26) is not indefinite because it would be obvious to one of ordinary skill in the art that the legacy and non-

legacy processing systems process the microdevices -- "providing the number of processed microdevices to be output from the legacy processing system and the non-legacy processing system" [underlining for clarity] (claim 1, lines 22-23 and claim 13, lines 22-23).

In response, the Examiner respectfully disagrees. The limitation does not answer who or what processes the microdevices but just states that they are processed microdevices and that a number is provided between a legacy and non-legacy system. No relationship has been established between providing the number of processed microdevices as being the processing. The way the limitation reads, the microdevices have already been processed. The Applicant's assertion that it would be obvious without any support is found to be unpersuasive.

26. Applicant argues on page 6 that no link or relationship is not required between "non-legacy information" and "system setup and shutdown parameters" and "system process-specific parameters".

In response, the Examiner respectfully disagrees. A relationship is required because an essential step is missing. The claim language recites system setup parameters and process-specific parameters but fails to show whether these parameters perform system setup or system shutdown functions, etc., or whether these parameters are related to the "controlling the handling of the microdivices" (line 23) or the "processing the microdevices" (line 24), for example. In the claim language, there are parameters for shutdown, setup and start up, but there is nothing to indicate a shutdown, setup or startup is being performed.

27. Applicant argues on page 7 that it would be obvious to those having ordinary skill in the art from the phrases quoted by the Examiner that the overall system, without being limiting, comprises three basic systems: the legacy processing system, the non-legacy processing system, and the computer system. Since the number and the parameters are provided to tow of the three basic systems, by process of elimination if not other, the third basic system, the computer system, provides the number and parameters.

In response, the Examiner respectfully disagrees. It is possible for a system to provide parameters for itself. The claim language does not necessarily infer that only the computer system provides the parameters. From the claim language, the non-legacy system could provide parameters for itself and the same for the legacy system. And from the claim language, the providing of the parameters can be done by the microdevices. No relationship has been established which connect the legacy and non-legacy systems as being microdevices.

In response to applicant's argument that the references fail to show certain features of applicant's invention (pages 8-9), it is noted that the features upon which applicant relies (i.e., "processing which is programming for programmable devices, which include but are not limited to devices such as Flash memories (Flash), electrically erasable programmable read only memories (EPROM), programmable logic devices (PLDs), field programmable gate arrays (FPGAs), and microcontrollers. However, the present invention encompasses processing for all electronic, mechanical, hybrid, and other devices which require testing, measurement of device characteristics, calibration, and other processing operations") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

28. Applicant argues on page 9 that Bodnar does not teach making the telephones "smarter" but rather relates to telephone docking units which are unrelated to processing microdevices.

In response, the Examiner respectfully disagrees. In col. 17, lines 33-66, Bodnar teaches using a "flash-based memory" that "contains phone-model-specific software for instructing the main unit to work with the docking unit's compatible model(s) of phone" (making it smarter by giving it the knowledge/instruction from the software).

29. On pages 10 and 12, the Applicant requests the Examiner to provide a reference in support of the Official Notice.

In response, Hagiuda et al. (US 6,182,225 B1) teaches a device processing system that has a user and administrator with a mode for the user and the administrator, which is secured by a password *(col. 18, lines 63-67 through col. 19, lines 1-33)*. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature of a user and an administrator mode with a password because this would increase control and security *(col. 2, lines 21)*.

30. Applicant argues on page 11 that Coburn does not teach programming and feeding microdevices.

In response, the Examiner respectfully disagrees. Coburn (and actually, Bodnar and Tynar) teaches programming and feeding devices with software and data/instructions *(page 1, [0005])*.

31. Applicant argues on page 13that Kenik relates to hardware components, while the claim limitations comprise software tasks and kits.

In response, the Examiner respectfully disagrees. The KIT program is software *(col. 8, lines 23-30, for example)*.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth Tang whose telephone number is (571) 272-3772. The examiner can normally be reached on 8:30AM - 6:00PM, Every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kt
2/28/05

MENG-AL T. AN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 21